UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,826	07/25/2001	Rajarshi Das	YOR920010348US1	7921

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EXAMINER
FADOK, MARK A

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 July 2004</u>.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-20* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Election Traversal

The examiner is receipt of applicant's response to election requirement mailed 7/1/2004, which was received 7/29/2004. Applicant has elected species IA, which includes claims 1-5 and 8-20, with traverse.

Applicant argues that the amendment provided in the response provides for a method which <u>cannot</u> be done by hand. The examiner disagrees and notes that accomplishing the method "in a data processing system" includes a method which is done by hand, since it is well known that people also process data. Further, applicant's argument concerning the examiners burden is unsupported, therefore, since the inventions show clear divergent subject matter the restriction is proper and is maintained. The applicant's traversal of the species requirement for species IA, however, was convincing and that restriction has been removed leaving claims 1-20 as pending in the instant application.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Applicant defined terms

Negotiation - "the term "negotiation" is used simply to refer to the process of making a business purchasing or selling decision. Such "negotiation" may entail offers and counteroffers, as is generally understood to be involved in a "negotiation" or may simply be a "take-it-or-leave-it "negotiation" in which a product is offered for sale with nonnegotiable terms. Any type of operational business purchasing and/or selling decision is intended to be within the scope of the term "negotiation" as it is used in this disclosure.

Exogenous preferences – "In addition to the previous history information, the present invention may further use exogenous preferences or constraints to influence the selection of a vendor or marketplace. For example, this exogenous preference or constraint information may include the names of known vendors to prefer or avoid, rank orderings of vendors to prefer for certain types of products, and the like."

Interoperability mechanisms – "(e.g., negotiation protocols, etc.)"

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1-8, 19 and 20 are rejected under 35 U.S.C. 102(e) as being

Anticipated by Al-Kazily (US 2002/0111874).

In regard to claim 1, Al-Kazily discloses a method of making purchasing

decisions for purchasing a product or service, comprising: obtaining one or more rules

identifying strategic purchasing policies (page 4, para 0039);

obtaining one or more attributes for the product or service to be purchased (page

2, para 0019); and

automatically making a decision to purchase the product or service from a vendor

based on the one or more rules and the one or more attributes (page 4, para 0041).

In regard to claim 2, Al-Kazily teaches wherein the one or more rules include

one or more rules directed to at least one of an identification of the types of products or

services that are to be purchased over a specified period of time, preferred terms and

conditions of purchases, preferred shipping or delivery policies, desired expiration times

on orders, target purchase prices, thresholds for maximum purchase prices, target

values for product/service or vendor quality metrics, rank orderings or relative weights

for calculating tradeoffs among different product/service or vendor attributes, sets of

products or services that may be substituted for each other, default policies for product

returns, rank ordered or weighted lists of preferred vendors, preferred payment

methods, and parameters used in automated price calculation algorithms (page 3, para

0034).

In regard to claim 3, Al-Kazily teaches wherein the one or more attributes

includes at least one of a maximum price to be paid for the product or service, a

maximum number of products for purchase, sets of products or services that may be

substituted for each other, information about which sets of products or services are

preferred, information such as rank orderings or weights for determining tradeoffs

among imperfectly substitutable products or services, information for determining

tradeoffs between product or service prices, order size, and delivery times, information

for determining tradeoffs between product or service prices and vendor preferences,

and thresholds for minimum acceptable quality measures (page 2, para 0019).

In regard to claim 4, Al-Kazily teaches wherein the product or service is

associated with a multi-attribute utility function that describes an interrelation between

multiple attributes of the one or more attributes (page 3, para 0033).

In regard to claim 5, Al-Kazily teaches wherein the one or more attributes are

dynamically set (page 3, para. 0031, determining order size based on available

inventory)

In regard to claim 6, Al-Kazily teaches wherein the one or more attributes are fixed (page 3, para. 0034).

In regard to claim 7, Al-Kazily teaches wherein at least one of the one or more attributes is dynamically set and at least one of the one or more attributes is fixed (see above).

In regard to claim 8, Al-Kazily teaches wherein a value of at least one of the one or more attributes is automatically set (page 4, para 0035 and 0036).

In regards to claim 19, Al-Kazily teaches storing a record of the purchase (FIG 4, item 42).

In regards to claim 20, Al-Kazily teaches wherein the method is implemented in a distributed data processing system (FIG 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-14,16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Kazily in view of Kansal (6647374).

In regard to claim 9, Al-Kazily teaches automatically choosing a vendor and sending an order request (page 6, para 0058 and page 5, para 0043), but does not specifically mention that the system is selecting a set of vendors from which the product or service may be purchased and evaluating each vendor in the set of vendors and choosing a vendor from the set of vendors from which to purchase the product or service. Kansal teaches selecting a vendor after evaluating their ability to service a contract (Abstract). it would have been obvious to a person having ordinary skill in the art at the time of the invention to use the vendor selection system of Kansal in the automated procurement system of Al-Kazily, because this would improve the selction process of vendors and maximize the time and efficiency of the company (Al-Kazily, page 2 para 004).

In regard to claim 10, the combination of Al-Kazily/Kansal teaches wherein automatically selecting a set of vendors includes: obtaining history information regarding one or more vendors; and selecting the set of vendors from the one or more vendors based on the history information (Kansal, FIG 1 and 2).

In regard to claim 11, the combination of Al-Kazily/Kansal teaches wherein the history information includes at least one of a previous history of purchases from the

vendor, a negotiation history with the vendor, and a fulfillment history with the vendor

(Kansal, col 6, table 1).

In regard to claim 12, the combination of Al-Kazily/Kansal teaches wherein

automatically selecting a set of vendors includes: obtaining exogenous preference

information for one or more vendors; and selecting the set of vendors from the one or

more vendors based on the exogenous preference information (Kansal, FIG 5).

In regard to claim 13, the combination of Al-Kazily/Kansal teaches wherein the

exogenous preference information includes at least one of identification information of

vendors to prefer, identification information of vendors to avoid, a rank ordering of

vendors, and a rank ordering of vendors to prefer for the product or service (Kansal, FIG

3).

In regard to claim 14, the combination of Al-Kazily/Kansal teaches wherein

automatically selecting a set of vendors includes: obtaining interoperability mechanism

information for one or more vendors; and selecting the set of vendors from the one or

more vendors based on the interoperability mechanism information (page 6, para 58).

In regard to claim 16, the combination of Al-Kazily/Kansal teaches wherein

automatically evaluating each vendor in the set of vendors includes negotiating with

each vendor for the purchase of the product or service based on the one or more rules

and the one or more attributes of the product or service (see claim 1 and page 6, para 0058).

In regard to claim 17, the combination of Al-Kazily/Kansal teaches wherein negotiating with each vendor includes at least one of selecting vendors by comparing prices in vendor on-line catalogs with a maximum price attribute for the product or service, placing one or more bids in an auction, and haggling over terms of the purchase (page 6, para 0059).

In regard to claim 18, the combination of Al-Kazily/Kansal teaches wherein negotiating with each vendor includes negotiating based on one or more negotiation parameters including at least one of: a threshold on a maximum price to offer; parameters of algorithms used to calculate the maximum price to offer; thresholds on minimum acceptable quality; how long before an end of an auction to stop attempts at obtaining a better deal; preferred increments in price when making counteroffers; preferences, weights, or rank orderings for evaluating tradeoffs among alternatives among substitutable products, product attributes, terms and conditions, delivery times or costs, and vendor attributes; tunable parameters of algorithms used in calculating offers; rank orderings of preferred algorithms to use with particular vendors; and information about which negotiation protocols are supported by each vendor in the set of vendors (page 2, para. 0034, price range which includes a maximum price).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Kazily in view of Kansal and further in view of Official Notice.

In regard to claim 15, the combination of Al-Kazily/Kansal teach automatically selecting vendors based on a plethora of interrelated information, but does not specifically mention that the information is coming from a third party. It was old and well known in the art at the time of the invention to get information from a third party source (ex. Better Business Bureau). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of Al-Kazily and Kansal obtaining information about one or more vendors from a third party; and selecting the set of vendors from the one or more vendors based on the information obtained from the third party, because this would be an additional source of information that could be used to assure that the risk is reduced in the selection of a vendor.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application

or proceeding should be directed to the Receptionist whose telephone number is

(703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306   [Official communications; including

After Final communications labeled

"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal

Drive, Arlington, VA, 7th floor receptionist.

Mark Fadok

Patent Examiner